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OFFICE OF PETITIONS

In re Patent No. 7,504,437 :
KOYAMA et al. : DECISION ON REQUEST FOR
Issue Date: March 17, 2009 : RECONSIDERATION OF PATENT
Application No. 10/629,108 : TERM ADJUSTMENT and
Filed: July 28, 2003 : NOTICE OF INTENT TO ISSUE
Attorney Docket No. 03338CIP/HG : CERTIFICATE OF CORRECTION

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d))" filed May 8, 2009. Patentees request that the patent term adjustment for the above-identified patent be corrected from fifty-eight (58) days to one hundred forty-six days (146) days.

The request for reconsideration of the patent term adjustment indicated in the patent is GRANTED to the extent indicated herein.

Patentees are given THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of eighty-one (81) days.

On March 17, 2009, the above-identified application matured into U.S. Patent No. 7,504,437 with a revised patent term adjustment of 58 days. The instant request for reconsideration was timely filed within two (2) months of the date the patent issued. See 37 CFR 1.705(d).

Patentees indicate that the above-identified patent is not subject to a terminal disclaimer.

Patentees assert that there were no circumstances that constituted a failure of the applicants to engage in reasonable efforts to conclude processing or examination of the application. Specifically, patentees dispute the reduction of twenty-three (23) days associated with the filing of the "LETTER RE: NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT" on December 12, 2008. Additionally, patentees disagree with the reduction of sixty-five (65) days based on the filing of the "LETTER RE: USPTO COMMUNICATION DATED DECEMBER 11, 2008" on January 12, 2009.

Pursuant to 37 CFR 1.704:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping: . . .

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or

(ii) Four months

Furthermore, the OG Notice states that:

... the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a

"failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001).

The record confirms that patentees filed a "LETTER RE: NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT" on December 12, 2008, after the mailing of the Notice of Allowance.¹ Nonetheless, under the circumstances specific to this case, the filing of the "LETTER RE: NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT" should not be considered "a failure to engage in reasonable efforts" to conclude processing or examination of an application and should not result in reduction of the patent term adjustment pursuant to 37 CFR 1.704(c)(10). The record reveals that patentee's first opportunity to raise this issue was on December 12, 2008, by filing the "LETTER RE: NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT." Accordingly, the reduction of twenty-three (23) days is not warranted and will be removed.

However, the Office is not persuaded as to patentees' assertion that no reduction under 37 CFR 1.704(c)(10) is warranted for filing the "LETTER RE: USPTO COMMUNICATION DATED DECEMBER 11, 2008" on January 12, 2009, after the mailing of the Notice of Allowance. This paper is not among the examples of the papers cited in the OG Notice, which do not cause substantial

¹ The PTA Calculation Sheet incorrectly shows that patentees filed the "LETTER RE: NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT" on December 9, 2008, instead of December 12, 2008. Nevertheless, both PALM and the Image File Wrapper indicate the Letter was filed on December 12, 2008.

interference and delay in the patent issue process. Thus, the filing of the "LETTER RE: USPTO COMMUNICATION DATED DECEMBER 11, 2008" on January 12, 2009, after the mailing of the Notice of Allowance is a proper basis under 37 CFR 1.704(c)(10) for reduction of the period of adjustment. Unlike the circumstances surrounding the filing of "LETTER RE: NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT" on December 12, 2008, the filing of the "LETTER RE: USPTO COMMUNICATION DATED DECEMBER 11, 2008" was not the first opportunity to raise the matter. Rather, patentees had already addressed this issue with the Examiner by filing the "LETTER RE: NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT" on December 12, 2008, and it was resolved by the Examiner in the Office communication mailed on December 31, 2008. Therefore, the reduction of sixty-five (65) days is merited and will remain.

In view thereof, the patent term adjustment indicated on the patent should be **eighty-one (81) days** (289 days of Office delay - 208 days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **eighty-one (81) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,504,437 B2

DATED : Mar. 17, 2009

INVENTOR(S) : Koyama et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (58) days

Delete the phrase "by 58 days" and insert – by 81 days--